

Remarks

Applicant adds new claims 46-49 and accordingly claims 24-49 are pending in the present application.

Claims 38-43 stand rejected for indefiniteness. Claims 24-28, 30-35, 37-40, 42-43 and 45 stand rejected for anticipation by U.S. Patent No. 5,184,179 to Tarr et al. Claims 29, 36, and 41 stand rejected for obviousness over Tarr in view of U.S. Patent No. 6,108,099 to Ohtani. Claim 44 stands rejected for obviousness over Tarr in view of Ohtani, U.S. Patent No. 5,841,982 to Brouwer, U.S. Patent No. 5,125,075 to Goodale, U.S. Patent No. 5,923,848 to Goodhand et al., U.S. Patent No. 4,819,191 to Scully et al., U.S. Patent No. 6,434,571 to Nolte, and U.S. Patent No. 5,647,002 to Brunson.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Applicant has amended claims 38 and 41 as indicated herein. The identified language which allegedly renders the claims indefinite has been deleted. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C §112, second paragraph.

Referring to the rejection of claim 24, teachings in columns 5 and 6 of Tarr are identified as allegedly disclosing limitations of claim 24. Such teachings of columns 5 and 6 of Tarr fail to disclose or suggest positively recited limitations of claim 24. For example, claim 24 positively recites detecting status information relating to a hard copy engine using a *sensor defined as included in the hard copy output engine*. It is further recited that the status includes the status of a future need for maintenance and *billing information for job accounting*. Claim 24 further recites composing an electronic message including the detected status and transmitting the electronic message to a scheduling engine. Accordingly, claim 24 recites detecting status information including billing information using a sensor included in a hard copy output engine. Claim 24 is patentable.

The identified teachings in columns 5 and 6 of Tarr fail to disclose or suggest numerous limitations of claim 24. As set forth in column 5, lines 46-54, a monthly meter count (corresponding to a counted number of pages processed by count detector 18) is stored in computer control 16 external of the

copier. The meter count is forwarded to billing computer 38 also external of the copier and which uses the count information to produce bills. *Absolutely no billing information is provided in Tarr until the meter count information is processed in the external billing computer 38.* Accordingly, Tarr fails to disclose or suggest detecting status information including billing information using a sensor included in a hard copy output engine and transmitting an electronic message including the billing information to a scheduling engine. Any messages from the copier of Tarr only include count data and fail to disclose or suggest any billing information for job accounting. Further, Tarr fails to disclose a scheduling engine. Numerous limitations of claim 24 are not shown or suggested by the prior art and claim 24 is allowable.

The claims which depend from independent claim 24 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 25 defines detecting *a toner low or toner out status* using the sensor of the hard copy output engine. Page 3 of the Action identifies teachings in column 5, line 60 spanning to column 6, line 2 as allegedly disclosing limitations of claim 25. The rejection of claim 25 is in error. For example, starting at line 62 of column 5 of Tarr, it is stated that by knowing the number of copies made *as reported by the monitoring system* and how much of each consumable good is used per copy, a monthly total of consumed goods may be calculated. This allows the *central station* (billing computer 38) to maintain consumable good inventories for each copier. The central station would then arrange for quick replenishing of low consumable good inventories. The described actions occur within the central station billing computer 38 using counted page information from computer control 16. Such operations of billing computer 38 fail to disclose or suggest the detecting *toner low or toner out status using a sensor of the hard copy output engine*, or the composing and transmitting an electronic message including the detected status of toner low or toner out. Positively recited limitations of claim 25 are not shown or suggested in the prior art of record and claim 25 is allowable for at least this reason.

Claim 29 stands rejected over Tarr and Ohtani. It is stated that it would

have been obvious to have the electronic message include a consumable order so that a user can order items to replace those that were consumed as disclosed by Ohtani. Applicant disagrees with the 103 rejection.

Referring to MPEP §2143.01 (8th ed.), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by a combination of references unless there is some motivation in the art to support the combination. See *ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Tarr provides teachings of messages from the copier including page count information and diagnostic information. The counted number of pages may be used to calculate consumable usage within billing computer 38 as set forth in columns 5-6. No consumable information is provided within components 12, 14 or 16 but rather such is derived within billing computer 38 using the number of pages counted. The teachings in Ohtani refer to providing an order form within an e-mail message. The system of Tarr fails to disclose usage of e-mail but rather communicates the number of pages counted with respect to consumables. One would not be motivated to combine teachings regarding an order within an e-mail provided by the system of Ohtani into a system configured to communicate messages including a counted number of pages or diagnostic information. There is no consumable information known in Tarr until billing computer 38 operates upon received data. Combining the teachings of Ohtani to provide information regarding a consumable order with the messaging of Tarr is nonsensical inasmuch any consumable information is not known in Tarr until subsequent moments in time when messaging is completed and the

messages are processed. There is no way to provide consumable information in Tarr before the messaging inasmuch as the consumable information is not yet known, and accordingly, one would not be motivated to provide a consumable order in the messages of Tarr. The Examiner has failed to provide the impetus necessary for one of ordinary skill in the art to combine the teachings of Ohtani with the teachings of Tarr and has improperly relied upon the teachings of Applicant's disclosure to combine the reference teachings.

The Examiner is respectfully reminded that a proper motivational rationale for a combination of art provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification ("Preferably, the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification". *Ex Parte Levensgood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted)).

The Federal Circuit recently discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references can not be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office can not rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 25 is improper without the proper motivation and Applicants respectfully request allowance of claim 25 in the next action.

Claim 31 recites an article of manufacture comprising computer readable code configured to cause a *processor to detect a status of a portion of a hard copy output engine from a sensor incorporated in the hard copy output engine, the status including detecting billing information for job accounting*, and composing and transmitting the electronic message including billing information for job accounting. Claim 31 is allowable.

Interface 12 and control 16 and other teachings of Tarr fail to disclose or suggest the claimed sensor incorporated in the hard copy output engine. Claim 31 is patentable for at least this reason.

Further, teachings of Tarr fail to disclose or suggest a sensor of the hard copy engine configured to detect billing information for job accounting. Interface circuit 12 intercepts diagnostic signals from a copier and places them in a form readable and usable by a computer 38 as set forth in column 7, lines 13-16. Counter detector 18 fails to disclose or suggest the claimed sensor incorporated in the hard copy output engine and configured to detect billing information for job accounting. Limitations of claim 31 are not shown or suggested and claim 31 is patentable for at least this additional reason.

In addition, disclosed components of Tarr fail to disclose or suggest a computer usable media having computer readable code to cause the processor to detect, compose and transmit as defined in claim 31. The Office Action is silent regarding identification of any teachings in Tarr allegedly disclosing the claimed article of manufacture, computer usable medium or computer readable code. Numerous positively recited limitations of claim 31 are not shown or

suggested in the prior art of record and claim 31 is allowable for at least this reason.

Claim 38 recites a system comprising, in part, a plurality of sensors coupled to a hard copy output engine, the sensors being configured to provide status relating to aspects of the hard copy output engine, and processing circuitry coupled to the sensors and configured to read the sensors and detect the status of aspects of the hard copy engine including billing information for job accounting, and to compose and transmit an electronic message including the detecting status. Claim 38 is allowable.

In Tarr, all billing information is determined subsequently to the messaging of the system. Tarr fails to disclose or suggest the composing and transmitting of an electronic message including status comprising billing information as claimed. Claim 38 is allowable for at least this reason.

Further, Tarr fails to disclose or suggest the claimed processing circuitry configured to read, compose and transmit an electronic message including status including billing information responsive to status information from sensors coupled with the hard copy output engine. No teachings are identified as allegedly disclosing or suggesting the claimed processing circuitry. Numerous limitations of claim 38 are not shown or suggested in the prior art of record and claim 38 is allowable for at least this reason.

The claims which depend from independent claim 38 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Claim 44 recites detecting a status of the hard copy output engine using a plurality of sensors incorporated in the hard copy output engine and which detect toner out and toner low and internal billing dates for job accounting and external billing dates for job accounting and composing and transmitting an electronic message including the detected status and other positively recited information.

Numerous references are cited as allegedly disclosing limitations of claim 44. The combined reference teachings fail to disclose or suggest detecting status including toner out, toner low, internal billing dates for job accounting and

external billing dates for job accounting, low paper, out of paper, low consumables, out of consumables using a plurality of sensors incorporated in the hard copy engine as positively recited in claim 44. The references describe deriving information responsive to received or communicated information regarding number of pages counted which fails to disclose or suggest detecting the claimed status using sensors incorporated in the hard copy engine as positively recited. Claim 44 recites limitations not shown or suggested in the prior art references taken alone or in combination and claim 44 is allowable for at least this reason.

Furthermore, there is no motivation to combine *the disparate teachings of the eight prior art references* in the absence of Applicant's disclosure. The Examiner has improperly engaged in utilization of Applicant's disclosure as a roadmap to formulate the obviousness rejection. There is no motivation to combine the numerous references apart from the teachings of Applicant's disclosure and the rejection of claim 44 is improper for at least this additional reason. Furthermore, the utilization of no less than eight references in support of the 103 rejection clearly illustrates the non-obvious nature of Applicant's claimed invention.

Moreover, some of the references are non-analogous subject matter and are properly relied upon in formulating the obviousness rejection. Non-analogous art areas cannot properly be combined for an obviousness rejection where the problems addressed by each are non-analogous from one another. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986.) A field of art is analogous *only* if one seeking the solution in one art area would be likely to seek the solution by referring to the other art. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225 USPQ 634 (Fed. Cir. 1985).

For example, Brouwer relates to a method and system for testing an operation of an electronic mail switch. Goodhand relates to a system and method for resolving names in an electronic messaging environment. Nolte relates to implementation of a meeting function in an electronic calendar. Scully relates to an electronic calendaring method to establish calendar floating triggers for calendared events and processes. Goodale discloses a system for circulating serially an electronic non-interchangeable unique route package from sender to

selected recipients. The teachings of Brunson relating to synchronization of mailboxes of different types. These references utilized to reject claim 44 are non-analogous subject matter and accordingly the rejection of claim 44 is improper for at least this additional reason.

Claim 45 recites a computer implemented control system comprising, in part, a plurality of sensors coupled to the hard copy output engine and configured to provide status information, and processing circuitry coupled to the sensors and configured to detect the status information and to compose an electronic message including the detected status and to transmit the electronic message to a scheduling engine. Claim 45 recites patentable subject matter.

The Office Action fails to identify any teachings which allegedly correspond to the claimed processing circuitry. Further, Tarr fails to disclose or suggest the claimed scheduling engine. Limitations of claim 45 are not shown or suggested in the prior art of record and claim 45 is allowable.

Numerous limitations are identified which are not shown nor suggested by the prior art. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

Support for the new claims may be found at least at on pages 6 and 7 and Fig. 3 of the originally filed specification.

Applicant respectfully requests allowance of all pending claims.

Serial No. 09/733,421
Case No. 10003228-1
Amendment C

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
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IN THE
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INVENTOR(S): Robert E. Haines

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Links

**VERSION WITH MARKINGS TO SHOW CHANGES MADE ACCOMPANYING
RESPONSE TO SEPTEMBER 26, 2002 OFFICE ACTION**

In the Claims

The claims have been amended as follows. Underlines indicate insertions
and ~~strikeouts~~ indicate deletions.

- 1 31. (Amended) An article of manufacture comprising a computer
2 usable medium having computer readable code embodied therein to cause a
3 processor to:
4 detect a status of a portion of ~~the~~ a hard copy output engine from a
5 sensor incorporated in the hard copy output engine, the detecting a status
6 including detecting a future need for preventative maintenance and billing
7 information for job accounting;
8 compose an electronic message including the detected status; and
9 transmit the electronic message to a scheduling engine.

1 38. (Amended) A computer implemented control system for a hard
2 copy output engine, the system comprising:

3 a plurality of sensors coupled to the hard copy output engine, the sensors
4 being configured to provide status information relating to ~~various~~ a plurality of
5 aspects of the hard copy output engine; and

6 processing circuitry coupled to the sensors and configured to:

7 read the sensors and detect the status of the ~~various~~ aspects of
8 the hard copy engine, the aspects including the need for preventative
9 maintenance and billing information for job accounting;

10 compose an electronic message including the detected status; and

11 transmit the electronic message to a scheduling engine.

1 41. (Amended) The computer implemented control system of claim
2 38, wherein the ~~various~~ aspects of the hard copy output engine include: toner
3 out, toner low, preventative maintenance alerts, including cleaning or
4 replacement of component parts, consumables orders, low paper, out of paper,
5 low consumables, out of consumables, and need maintenance.

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